



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,389	09/28/2005	Michael Bauer	2732-168	6518
6449 7590 05/19/2009 ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005				
EXAMINER DICUS, TAMRA				
ART UNIT 1794		PAPER NUMBER		
NOTIFICATION DATE 05/19/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary

Application No.

10/531,389

Applicant(s)

BAUER ET AL.

Examiner

TAMRA L. DICUS

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The specification objection is withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. That the film has a “not very pronounced surface relief” is not particularly clear as it is a relative phrase and the specification is absent a definite meaning to this term.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9-10, and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 6,471,248 to Hardwick et al.

Hardwick teaches a security data carrier ID (banknotes and the like, 1:18), wherein the substrate is embossed, has moiré patterns, includes diffracting gratings and optical variable devices (embraces relief and holographic structures), and fine line or filigree patterns (3:1-10, embraces guilloches). Thus the areas where and where not are printed and embossed are inherently tactilely perceptible. The substrate 10, Fig. 6 and associated text, is provided with printed patterns 56 covered in part by opacifying TiO₂ ink 15 and 16 creating windows (gap). Because the ink 15 and 16 is printed, by intaglio process is not weighed heavily (see below), it is considered to be the recited film. See also 4:20-45, 6:15-50. Claims 1-6, 9-10 and 12 are met.

Product-by-process claims are not limited to the manipulations of the recited steps (i.e. intaglio printing), only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same. Thus, the not very pronounced surface relief and tactile perceptibility features are

inherently present because the same print and film material and structure is applied as claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,471,248 to Hardwick et al in view of US 6,505,779 to Power et al.

Hardwick, as set forth above essentially teaches the claimed invention. In the event that the process limitations prove to structurally differ from Hardwick, the following rejection is applied.

While not teaching intaglio printing of the printed opacifying ink layers or its thickness, Power, analogously directed, teaches the advantages of such a printing.

Powers explains opacifying ink layers, applied in a similar fashion as windows, in intaglio print conceal the security indicia at oblique angles in reflected light because of the height of the intaglio lines (and thus height and thickness are result effective features). While not teaching an exact height, it is obvious to shape or size it also dependent upon how much concealing is desired. See 2:25-40, 3:1-35, 4:1-25. It is submitted the optimal and/or claimed values of the respective material would have

been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980). See also MPEP § 2144.05 II (B). Analysis of whether the subject matter of a claim would have been obvious need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336-37 (Fed. Cir. 2006)). Motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

It would have been obvious to one having ordinary skill in the art to have modified the security of Hardwick by including intaglio printing to alter the height of the ink to effectively conceal the underlying indicia as taught and cited above by Powers.

Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,471,248 to Hardwick et al in view of US 6,505,779 to Power et al, as applied to claim 1 above, and further in view of US 6,474,695 to Schneider et al.

The combination is set forth above.

While not explicitly stating “surface relief and holographic embossed structures” security features, claims 5 and 7, Schneider explicitly teaches the security features.

Schneider teaches security bank notes and ID (identity) cards having optically effective structures such as embossed holograms or diffraction or relief structures to affect the different viewing angles and coloring. See 3:25-41, 4:1-55, col. 6 and col. 11.

It would have been obvious to one having ordinary skill in the art to have modified the combination to include holograms or surface relief as claimed because Schneider teaches it adds to differing angles and coloring of a security as cited above.

Response to Arguments

Applicant argues that because Hardwick discloses printing on a substrate with windows, that tactile perceptibility of the intaglio printing is not maintained. However, as stated prior, the fact that printing is claimed as a process derived print, “intaglio” is considered the process, and does not change the final product, i.e. carrier with print and film on it in the order claimed.

Applicant argues that Hardwick doesn't disclose at least one printed area having tactile perceptibility and maintaining it because he alleges that Hardwick's device 20 is embedded. However, this argument is not convincing because the Examiner relied on printed area printed with the same intaglio print, elements 15 and 16, as having said

tactile perceptibility, not the device. Applicant argues the print doesn't protect against forgery however, this is not convincing because Applicant does not claim a print that protects against forgery, but a data carrier and Hardwick teaches the ink for security. Further Applicant has not provided evidence to the ink not being able to prevent forgery.

Applicant's claim 5 as amended is still vague and indefinite because "not very pronounced" is relative as set forth prior.

Applicant further points to thicker inking 16 and embossing 14 of Applicant's instant specification FIG. 3, this however is not expressed in the claims. If placed in the claims, it would make it better to understand what is intended.

Applicant argues Power, however, Power was used to show intaglio printing is a conventional way of printing (while again not needed because it is a method as explained above).

Applicant argues opacifying inks are irrelevant; the Examiner just referenced it so that it is clear both references use these inks in similar securities.

Applicant argues the film modification would not have tactile perceptibility, however this is speculative. Schneider is used for the same reasons above.

A *prima facie* case has been established, and therefore the burden shifts to the Applicant to submit additional objective evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. Arguments of counsel cannot take the place of

factually supported objective evidence. See, e.g., *In re Huang*, 100 F.3d 135,139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699,705, 222 USPQ 191, 196 (Fed. Cir. 1984). Until the Applicant has convincingly argued or has provided evidence to the contrary, the rejections are maintained.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Bernatz, acting SPE for Carol Chaney, can be reached on 571-272-1505. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tamra L. Dicus /TLD/
Examiner
Art Unit 1794

May 14, 2009

/Bruce H Hess/
Primary Examiner, Art Unit 1794